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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,239	07/05/2000	Terry A. Johnson	023890-031 (SD-8267)	4991
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FLIESLER DUBB MEYER & LOVEJOY, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111				
			EXAMINER	
			NGUYEN, HUNG	
			ART UNIT	PAPER NUMBER
			2851	

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/610,239

Applicant(s)

JOHNSON ET AL.

Examiner

Hung Henry V Nguyen

Art Unit

2851

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22 and 24-26 is/are allowed.
- 6) ☒ Claim(s) 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s), _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 27-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification of the disclosure lacks adequate support for the claimed provision of “wherein each blade does not move relative to the other blades” (see claims 27, 28) and “a plurality of blades that are fixedly secured to the frame” (see claims 33 and 34).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 27-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 27-32, the recitation of “wherein each blade does not move relative to each other” is indefinite (see rejection under 35 U.S.C. 112, first paragraph).

As to claim 33-34, the recitation of “a plurality...fixedly secured to the frame” is indefinite (see rejection under 35 U.S.C. 112, second paragraph, *supra*).

Rejection, 35 U.S.C. 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 33 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by McCullough (U.S.Pat. 6,097,474).

As best the claimed subject matters are understood (see rejection under 35 U.S.C. 112, first and second paragraphs, supra). Claims are anticipated by references.

With respect to claims 33 and 34, McCullough discloses an exposure device having an illumination system (10) for generating an energy beam and a shutter (20) including a frame (28) defining an aperture and a plurality of rectangular blades (48) which are “fixedly” secured to the frame via frame bores and pivot pins (see fig.3) and parallel to each other (see fig.3) and means (for example: extension support 54) for moving the frame to cause the blades to block or to allow the energy beam to travel through the aperture (see col.4, lines 35 to column 6 line 51; and col.13, lines 27-30).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCullough (U.S. Pat. 6,097,474).

As to claims 27 and 28, McCullough discloses an exposure apparatus comprising substantially all of the limitations of the instant claims as discussed. McCullough does not expressly disclose “each blade does not move relative to the other blades” (it is noted herein that this limitation is not supported in the specification of the instant application. See rejection under 112, first and second paragraphs). However, McCullough further teaches “adjustments to the illumination energy are made by moving push rods 34 which displace blades 48 selectively into the illumination energy or flux. Push rods 34 are independently adjusted by turning nuts 39” (see col.4, lines 52-56 and fig.3). This provides a clear suggestion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to displace each blade independently for adjusting the illumination energy passing through the shutter. In other words, it would have been obvious an obvious matter of design choice to a skilled artisan to move the plurality of blades (48) as taught by McCullough, “where each blades does not move relative to other blade” for the purpose of varying the illumination energy passing through the shutter thereby providing a proper illumination energy for the exposure device.

As to claims 29-32, McCullough lacks to disclose that the plurality of blades are secured to the frame with an adhesive such as epoxy adhesive. It is the Examiner's position that it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize well known "epoxy adhesive" in the device of McCullough to secure the blade to the frame. The motivation for doing so would have been to secure the blades to the frame in the highest level since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Allowable Subject Matter

10. Amended claims 1-13, 14-22, 24-26 are allowed. The following is a statement of reasons for the indication of allowable subject matter: While the prior art of record teaches a shutter having a plurality of blades pivotally attached together linked to push rods and inserted into an illumination field where the blades are moved to adjust the illumination intensity but does not specifically disclose a shutter having the blades being secured onto a frame and rotated about an axis that is normal to the substantially planar surfaces of the blades, and in conjunction with a drive means for moving the frame, as recited in the instant claims.

Response to Amendment/Arguments

11. Applicant's amendment filed July 28, 2003 have been entered. Claims 1, 11-14, , 24-26 have been amended. Claims 10, 23 have been cancelled. New claims 27-34 have been added. Applicant's arguments with respect to the rejections under 35 U.S.C. 112, first and second

paragraphs, as well as the prior rejections have been carefully reviewed but they are not found persuasive.

In response to the rejection of the claims under 35 U.S.C. first paragraph, Applicant argues that the limitations of “wherein each blade does not move relative to the other blades” are supported in the specification. The applicant is reminded that when claimed elements that are not clearly discussed in detail, this falls under 112, first paragraph, applicant’s disclosure is lacking in this aspect and for this reason, one having ordinary skill in the art is unable to ascertain the particularities and the highlights of applicant’s claimed invention. This is especially true for applicant’s arguments when pointed to specific sections of the specification, for example applicant’s argument for claim 27, for its support applicant’s relies upon ambiguous statement of “a plurality of blades that are secured to the frame” (page 2, lines 15-17) and the applicant relies upon page 4, lines 1-12 where it describes how to secure the blades to the frame. The Examiner respectfully disagrees with the applicant because the mere fact that “a plurality of blades that are secured to the frame” does not mean that “(wherein) each blade does not move relative to the other blades” as claimed (claim 27). Applicant also argues that since epoxy is used, therefore “the shutter blades are secured to the frame in a fashion in which they do not move. Further, that they do not move, and moreover do not move relative to one another is a correct description of their state after being glued by epoxy to the frame”. The Examiner does not understand the applicant’s position since if “the blades do not move” as argued by the applicant, how “the plurality of blades rotates about an axis that is normal to the substantially planar surfaces of the plurality of blades” as claimed in amended claim 1 and amended claim 14. In this regard, if the applicant does not agree with the Examiner, he/she is requested to provide

an explanation. As presently set forth, the Examiner respectfully submits that the claims 27-34 are indeed unclear and not supported in the instant disclosure as required by 35 USC 112.

Turning to the prior art rejection, the newly added claims are met by the prior art of McCullough et al as set forth above.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

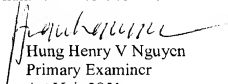
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Henry V Nguyen whose telephone number is 703-305-6462. The examiner can normally be reached on Monday-Friday (First Friday off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on 703-308-2847. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9318.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4900.


Hung Henry V Nguyen
Primary Examiner
Art Unit 2851

hvn
11/7/03